REMARKS

In the Office Action, the Examiner rejected claims 29-48. Currently, claims 29-48 are pending in the present application and are believed to be in condition for allowance. In view of the following remarks, Applicants respectfully request allowance of all pending claims.

Rejections under Section 102

In the Office Action, the Examiner rejected claims 46 and 47 as being anticipated by Mateos (US Patent Publication 2003/0050995). Applicants respectfully traverse this rejection.

Legal Precedent and Guidelines

First, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); *see also In re Morris,* 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. *See id.*

Second, interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into

how a person of ordinary skill in the art understands a claim term provides an objective

baseline from which to begin claim interpretation." *See Collegenet, Inc. v. ApplyYourself,*

Inc., 418 F.3d 1225, 75 U.S.P.Q.2d 1733, 1738 (Fed. Cir. 2005) (quoting *Phillips v. AWH*

Corp., 75 U.S.P.Q.2d 1321, 1326). The Federal Circuit has made clear that derivation of

a claim term must be based on "usage in the ordinary and accustomed meaning of the

words amongst artisans of ordinary skill in the relevant art." *See id.*

Third, anticipation under section 102 can be found only if a single reference

shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227

U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102,

every element of the claimed invention must be identically shown in a single reference.

In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper

rejection under section 102, a single reference must teach each and every limitation of the

rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

Accordingly, the Applicants need only point to a single element not found in the cited

reference to demonstrate that the cited reference fails to anticipate the claimed subject

matter. The prior art reference also must show the *identical* invention "*in as complete*

detail as contained in the ... claim" to support a *prima facie* case of anticipation.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed.

Cir. 1989).

Features of Claim 46 Missing from the Cited Reference

The present rejection is flawed because claim 46 recites a number of features missing from the cited reference. For instance, claim 46 recites a "first embedded object [that] is executable on a client remote from the server *to request the dynamic data*." (Emphasis added.) In sharp contrast, Mateos does not teach an embedded object that requests dynamic data when executed on the client.

Mateos teaches an HTML document that is sent to a client computer in its entirety with all of the relevant data. Mateos, abstract. Mateos teaches that the HTML document includes dynamic information (Mateos, paragraphs 57 and 58), and that the dynamic information is transmitted with the HTML document in the header information of the HTML document (Mateos, abstract).

Mateos does not, however, teach that this dynamic information is acquired by the client computer by executing an embedded object on the client computer. Mateos teaches that the "dynamic information" is retrieved before the HTML is to the client computer. *See id.* at paragraph 58. Then, the dynamic information and script variables referring to the dynamic information are sent as part of the same HTML document. *See* Mateos, abstract. In the document, the dynamic information is placed in the header, and the script variables are placed in the body. *See id.* Thus, the dynamic information is not requested by an embedded object executed on the client, as the client already has the dynamic information when it receives the script variables. The dynamic information is sent to the client before the embedded object. Indeed, in the Office Action, the Examiner recognizes

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that Mateos "does not specifically teach wherein the requesting of the data corresponding

to the embedded JavaScript code was requested from the server after receiving the frame

from the managed server." Office Action, page 4. Thus, Mateos does not teach an

embedded object that is executable on a client to request dynamic data. In view of this

missing feature, Applicants respectfully request that claim 46 and its dependent claims be

allowed.

Rejections under Section 103

In the Office Action, the Examiner rejected claims 29-43 as being obvious over

the Mateos in view of Pettersen (US patent 6,826,594). The Examiner also rejected

claims 44 as being obvious over Mateos in view of Pettersen and further in view of Chen

(US patent 6,021,437), claim 45 as being obvious over Mateos, Pettersen, and Lynch (US

patent 6,823,319), and claim 48 as being obvious over Mateos and "Compaq Remote

System Management for Industry Standard Servers" (the "Compaq reference").

Legal Precedent and Guidelines

The burden of establishing a *prima facie* case of obviousness falls on the

Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In

addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR*

International Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007), reaffirmed many of its

precedents relating to obviousness including its holding in *Graham v. John Deere Co.*,

383 U.S. 1 (1966). In *Graham*, the Court set out an objective analysis for applying the

statutory language of §103:

> Under § 103, the scope and content of the prior art are to be
> determined, differences between the prior art and the
> claims at issue are to be ascertained, and the level of
> ordinary skill in the pertinent art are to be resolved.
> Against this background the obviousness or non-
> obviousness of the subject matter is to be determined. Such
> secondary considerations as commercial success, long-felt
> but unresolved needs, failure of others, etc., might be
> utilized to give light to the circumstances surrounding the
> origin of the subject matter sought to be patented. *KSR*,
> s*lip op.* at 2 (citing *Graham*, 383 U.S. at 17-18).

In *KSR*, the Court also reaffirmed that "a patent composed of several elements is

not proved obvious merely by demonstrating that each of its elements was, independently,

known in the prior art." *Id.* at 14. In this regard, the *KSR* court stated that "it can be

important to identify a reason that would have prompted a person of ordinary skill in the

relevant field to combine the elements in the way the claimed new invention does ...

because inventions in most, if not all, instances rely upon building blocks long since

uncovered, and claimed discoveries almost of necessity will be combinations of what, in

some sense, is already known." *Id.* at 14-15. Traditionally, to establish a *prima facie*

case of obviousness, the CCPA and the Federal Circuit have required that the prior art not

only include all of the claimed elements, but also some teaching, suggestion, or

motivation to combine the known elements in the same manner set forth in the claim at

issue. *See, e.g., ASC Hospital Systems Inc. v. Montifiore Hospital*, 221 U.S.P.Q. 929, 933

(Fed. Cir. 1984) (holding that obviousness cannot be established by combining the

teachings of the prior art to produce the claimed invention absent some teaching or

suggestion supporting the combination.); *In re Mills*, 16 U.S.P.Q.2d 1430, 1433 (Fed.

Cir. 1990) (holding that the mere fact that references can be combined or modified does

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not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination). In *KSR*, the court noted that the demonstration of a

teaching, suggestion, or motivation to combine provides a "helpful insight" in

determining whether claimed subject matter is obvious. *KSR, slip op.* at 14. However,

the court rejected a *rigid* application of the "TSM" test. *Id.* at 11. In this regard, the

court stated:

> The obviousness analysis cannot be confined by a
> formalistic conception of the words teaching, suggestion,
> and motivation, or by overemphasis on the importance of
> published articles and explicit content of issued patents.
> The diversity of inventive pursuit and of modern
> technology counsels against limiting the analysis in this
> way. In many fields it may be that there is little discussion
> of obvious techniques or combinations, and it often may be
> the case that market demand, rather than scientific literature,
> will drive design trends. *Id.* at 15.

In other words, the *KSR* court rejected a rigid application of the TSM test which

requires that a teaching, suggestion or motivation to combine elements in a particular

manner must be explicitly found in the cited prior art. Instead, the *KSR* court favored a

more expansive view of the sources of evidence that may be considered in determining an

apparent reason to combine known elements by stating:

> Often, it will be necessary for a court to look to interrelated
> teachings of multiple patents; the effects of demands
> known to the design community or present in the
> marketplace; and the background knowledge possessed by
> a person having ordinary skill in the art all in order to
> determine whether there was an apparent reason to combine
> in the known elements in the fashion claimed in the patent
> at issue. *Id.* at 14.

The *KSR* court also noted that there is not necessarily an inconsistency between the idea underlying the TSM test and the *Graham* analysis, and it further stated that the broader application of the TSM test found in certain Federal Circuit decisions appears to be consistent with *Graham*. *Id.* at 17-18 (citing *DyStar Textilfarben GmbH and Co. v. C.H. Patrick Co.,* 464 F.3d 1356, 1367 (2006) ("Our suggestion test is in actuality quite flexible and not only permits but *requires* consideration of common knowledge and common sense"); *Alza Corp. v. Mylan Labs, Inc.,* 464 F.3d 1286, 1291 (2006) ("There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires a teaching to combine ... ")).

Furthermore, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 ("To facilitate review, this analysis should be made explict. See *In re Kahn,* 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."); *see also, In re Lee,* 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*).

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When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01(V).

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First Rejection

In the Office Action, the Examiner rejected claims 29-43 as being obvious over Mateos in view of Pettersen. Applicants respectfully traverse this rejection.

1) *Improper Combination - Lack of Objective Evidence of Reasons to Modify/Combine*

The Examiner has not shown the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Mateos and Pettersen references based on the conclusory and subjective statement that it would have been obvious "for the embedded JavaScript code of Mateos to have requested the dynamic information from the server after the embedded code had been retrieved by the client, because Pettersen teaches that the flexibility provided by the dynamic content in accordance with said techniques provides the advantage of being able to adjust to dynamically changing conditions (column 11, lines 32-39: 'advantage')." Office Action, pages 4 and 5. However, this is merely the speculative opinion of the Examiner that is inconsistent with Mateos, who already teaches a technique for constructing a web page with dynamic information reflecting changing conditions, and Examiner has not provided any evidence to indicate why one of ordinary skill in the art would find the technique taught by Mateos inadequate and modify it with the process for forming a web page taught by Pettersen.

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One of skill in the art would not combine these references unless the combination provided a benefit that neither reference provided in isolation. That is, the combination must have some utility over each reference; otherwise, there would have been no reason to combine them. To do otherwise adds complexity and cost with no benefit. In the present case, if Mateos's system accomplishes a given task, there would have been no reason to combine Mateos with Pettersen to accomplish the same task, yet the Examiner speculates that an artisan would combine Mateos with Pettersen because the combination would offer "a web page with the dynamic information." However, the system taught by Mateos already offered these benefits. Thus, an artisan would simply have implemented the system taught by Mateos to achieve "a web page with dynamic information reflecting changing conditions" without having had any motivation to turn to the Pettersen reference. The Examiner still has not met his burden to explain why one of ordinary skill in the art would combine these references.

2) *The References Teach Away from the Proposed Combination*

As summarized above, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Here, the Pettersen reference teaches away from acquiring data in the manner taught by the Mateos reference.

The Pettersen reference teaches a remote content management system in which a web site and advertisements to be inserted into the web site are requested from different servers. *See* Pettersen, col. 6, ll. 8-21, and Fig. 11. The primary web page 791 comes

from the affiliate web server 791, and the inserted advertisement data comes from the server 781 for a content serving website 780. *Infra.* To explain the utility of such a system, the Pettersen reference emphasizes both the importance of storing the advertisement data on a remote server and the problems associated with placing the advertisement data on the affiliate's web server. *See* Pettersen, col. 2, ll. 32-40. Thus, the Pettersen reference teaches away from acquiring the primary web page and the data inserted into the web page from the same server.

In contrast, Mateos teaches precisely the arrangement of web servers and inserted data that the Pettersen system is designed to avoid. The Mateos reference teaches a server that gathers all of the relevant information on a single server before serving the web page to a client. *See* Mateos, Abstract (explaining that the dynamic information is transmitted to the client as part of the header of the web page HTML). In Mateos, the dynamic information comes from the same server that provides the primary web page in which the dynamic information is inserted. Thus, the Mateos reference teaches web pages that are received by the client in their entirety, so Mateos teaches acquiring the web page and the inserted data from the same server.

The proposed modification is improper because the references teach away from one another. The Pettersen reference teaches that frequently changing data that is inserted into a web page should not be acquired from the same server as the web page, and the Mateos reference teaches acquiring the dynamic information from the same server that provides the web page in which the data is inserted. Because these references

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teach away from each other, one of ordinary skill in the art would not combine the cited

references as proposed. For this reason also, the Examiner has not met his burden.

3) *Features of Claim 29 that are Missing from the Cited References*

The Examiner's rejection is flawed for a number of other reasons, not the least of

which being that the cited references do not teach all of the recited claim features. In

claim 29, the same server both serves a web page and receives a request for an object file.

Claim 29 recites "serving a web page to a requesting computer from <u>a managed server</u>,"

and "receiving a request from the requesting computer to <u>the managed server</u> for the

object file." (Emphasis added.) Both of these phrases refer to the same managed server.

The cited references, however, do not teach or suggest, alone or in hypothetical

combination, a managed server that both serves a web page comprising a source call to an

object file and receives a request for the object file.

In sharp contrast, Mateos teaches web pages that are delivered in their entirety

with both the dynamic information and the script variables referring to the dynamic

information, so no request is received by the managed server for the object file. The

relevant data for constructing the webpage is sent to the client in a single step. Before the

web page is sent to the client, the dynamic information is inserted into the header of the

web page's HTML, and instructions for displaying the dynamic information is inserted

into the HTML. Mateos, abstract. Thus, Mateos teaches serving of the webpage and the

dynamic information at the same time without a separate request for an object file.

The Pettersen reference teaches a remote content management system in which a web site and advertisements to be inserted into the web site are requested from <u>different</u> servers. *See* Pettersen, col. 6, ll. 8-21, and Fig. 11. Specifically, the Pettersen reference teaches serving a website with the following steps:

1) an <u>affiliate web server 791</u> serves a web page 793 to a user system 760 (Pettersen, Fig. 11 and column 6, lines 39-41);

2) the user system 760 then requests advertisements from a web server 781 for a content serving website 780 (Pettersen, Fig. 11 and column 7, lines 13-16); and

3) the user system 760 then inserts the advertisements into the web page 793 (Pettersen, Fig. 11 and column 7, lines 34-37).

Pettersen's affiliate web server 791 is not the same server as the web server 781, so the request to the web server 781 for advertisements is not a request <u>to the affiliate web server 791</u>. In other words, the user system 760 does not request the advertisements from the server 791 that provides the web site. *See id* at col. 7, ll. 5-15. That is, different servers provide the web site and the inserted advertisement data. Thus, the Pettersen reference does not teach or suggest a managed server that <u>both</u> serves a web page comprising a source call to an object file and receives a request for the object file.

In view of these deficiencies, among others, the Pettersen reference and the Chen reference, taken alone or in hypothetical combination, cannot render obvious claim 29 or the claims that depend therefrom.

4) *Features of Claim 37 that are Missing from the Cited References*

The Examiner's rejection of claim 37 is also flawed. The cited references do not teach or suggest, alone or in hypothetical combination, "requesting data corresponding to the first embedded object from the managed server <u>after</u> receiving the frame from the managed server," as recited by independent claim 37. (Emphasis added.) That is, in claim 37, data corresponding to the first embedded object is requested from the same server that provided the frame. In contrast, as noted above, the Mateos reference teaches web pages that are received by the client in their entirety. In other words, these web pages do not prompt a client computer to request additional data from the server providing the web pages, so Mateos does not teach requesting data corresponding to an embedded object from any server, let alone from a server that previously provided a frame. Further, as discussed above, the Pettersen reference teaches a remote content management system in which a web site and advertisements to be inserted into the web site are requested from different servers. *See* Pettersen, col. 6, ll. 8-21, and Fig. 11. Thus, even if, *ad arguendo*, the web server 791 for the affiliate site 190 were a managed server, the advertisements would be provided by another web server 781 associated with the advertisements, and any requests for the advertisements would not be from the server 791 that provides the web site. *See id.* at col. 7, ll. 5-15. Thus, the cited references, taken

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alone or in hypothetical combination, do not teach or suggest all the steps of independent claim 37.

Second, Third, and Fourth Rejections

In the Office Action, claim 44 was rejected as being obvious over Mateos in view of Pettersen and Chen, and claim 45 was rejected as being obvious over Mateos in view of Pettersen and Lynch. Claim 48 was rejected as being obvious over Mateos in view of Pettersen and the Compaq reference. Applicants respectfully traverse these rejections.

As explained above, Mateos and Pettersen are improperly combined. Mateos teaches forming a webpage by gathering all of the relevant data on the server before transmitting the webpage to the client, and Pettersen teaches transmitting the data from which the webpage is formed from two different servers. Pettersen teaches the undesirability of forming a webpage by gathering all of the relevant data on a single server. Thus, Pettersen teaches away from the proposed combination with Mateos. In view of this improper combination, applicants respectfully request that the rejection of claims 44, 45, and 48 be withdrawn.

Applicants also note that the cited references in the second and third rejection do not teach all of the features of the parent claim of claims 44 and 45. Claims 44 and 45 depend from claim 37, which recites, "requesting data corresponding to the first embedded object from the managed server after receiving the frame from the managed server." As explained above, neither Mateos or Pettersen, taken alone or in hypothetical combination, teaches or suggests these features. Moreover, the additional references in

the second and third rejections also fail to teach or suggest these missing features. Thus, for this reason also, Applicants respectfully request that the rejection of claims 44 and 45 be withdrawn.

Similarly, the addition of the Compaq reference fails to cure the abovementioned deficiency in the Section 102 rejection of claim 48's parent claim 46. As noted above, Mateos does not teach a "first embedded object [that] is executable on a client remote from the server *to request the dynamic data*." (Emphasis added.) This feature is not taught by the Compaq reference, so for this reason also, the rejection of dependent claim 48 should be withdrawn.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: July 30, 2008

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